

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT BARRITZ

Appeal No. 2005-0420
Application No. 09/389,858

ON BRIEF

Before THOMAS, KRASS, and SAADAT, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-17, and 19-60.

Claim 18 has been cancelled.

The invention is directed to the management of information about existing, planned, or proposed hardware and software assets in data centers.

Representative independent claim 1 is reproduced as follows:

1. A method for assessing the financial cost of ownership of a configuration of at least one computer data center defined by a plurality of elements, through the use of systematic, computer assisted procedures, the method comprising the steps of:
 - a) modeling elements of a data center configuration on a computer by identifying to the computer the elements of a given configuration;
 - b) providing in a knowledge base financial information which reflects financial ownership costs of the elements associated with a predetermined class of computers, including substantially all of the modelled elements of the given configuration;
 - c) correlating information stored in the knowledge base with elements of the configuration; and
 - d) outputting at least a portion of the configuration and at least a portion of the associated information to a user.

The examiner relies on the following references:

Beck et al. (Beck)	6,138,139	Oct. 24, 2000 (filed Oct. 29, 1998)
Li	6,144,954	Nov. 07, 2000 (filed Jan. 27, 1998)

Claims 1-17, and 19-60 stand rejected under 35 U.S.C. §103 as unpatentable over Beck in view of Li.

Reference is made to the briefs and answer for the respective positions of appellant and the examiner.

OPINION

In rejecting claims under 35 U.S.C. §103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teachings, suggestions or implications in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the

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evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived.

At the outset, on a procedural note, the examiner's answer refers to Paper No. 7 (answer-page 3) for an explanation of the outstanding rejection. But reference to Paper No. 7 finds that this paper refers us back to "the Office action mailed on 07/13/2001" (Paper No. 7-page 2) for an explanation of the outstanding rejection.

Incorporation by reference of more than a single previous action is prohibited. MPEP §1208. If the examiner persists in this prohibited action in the future, a remand may be expected.

The examiner's rationale for the rejection of the independent claims, in toto, is as follows:

Beck substantially discloses a method/apparatus for supporting diverse interaction paths within a multimedia communication center (CINOS) Fig 1, wherein a plurality of communication centers such as center 17 cooperatively service a common pool of customers. Enterprises involved in commerce such as large financial institutions hosting many geographically separate communication centers (which is readable as Applicant's claimed

invention wherein said a method for assessing the financial of ownership of a configuration of at least one computer data center defined by a plurality of elements, through the use of systematic, computer assisted procedures, the method comprising the steps of:

modeling elements of a data center configuration on a computer by identifying to the computer the elements of a given configuration (see., abstract, col 7, lines 1-2, col 8, lines 1-11);

providing in a knowledge base financial information (see., abstract, col 10, lines 54-67, col 11, lines 1-16);

correlation information in the knowledge base (see., col 12, lines 28-35);

outputting at least a portion of the configuration and at least a portion of the associated information to a user (see., col 12, lines 36-46). **Beck** does teach a knowledge base to achieve desired interaction within a financial institution, but he fails to specifically disclose a knowledge base for configuring financial cost within an institution. **Li** discloses an expert system that has a knowledge base, an inference engine, a knowledge acquisition module, and explanatory interface for rapidly generating, reliable, low cost knowledge bases. These knowledge bases, including the self-optimized, numerical values (see., col 13, lines 61-67, col 14, lines 1-11, lines 32-54).

Accordingly, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the financial institution of **Beck** by including an expert system or artificial intelligence as taught by **Li** because such modification would provide the financial institution of **Beck** with an expert system or Knowledge base that can generate automatically its own knowledge bases, and which immediately and continuously replaces these new knowledge bases with still newer and more accurate knowledge bases for continuously optimal results (see **Li**, col 4, lines 1-6). This would have been obvious because **Beck** and **Li** both are directed toward knowledge base, in order to calculate such as low cost and numerical values, and one of ordinary skill in the art would have recognized these similarities and concluded that they

are from the same field of endeavor. Therefore, it would have been obvious to one of ordinary skill in the art to incorporate an expert system or knowledge base as taught by Li into the financial institution of Beck because it is the basic definition of an expert system, it is comprised of an knowledge base for calculating data or numerical data, an inference engine to provide advises [sic] (Paper No. 5, pages 3-4).

It is appellant's position that Beck does not relate to a "computer data center," does not describe any modeling of such a computer data center, and does not disclose or suggest the "costs of ownership" calculations aspect of the instant invention. Appellant further contends that Li is only concerned with automation of the development of computer software, and has nothing to do with the modeling of software or hardware elements or with the calculation of costs of ownership thereof.

In particular, appellant points out that, rather than being directed to a "computer data center," as claimed, Beck is concerned with a "multimedia communication center," similar to a telephone switching system, but handling both voice/video information and digital data. Moreover, argues appellant, Beck does not engage in any modeling, let alone modeling of actual hardware or software, as the instant invention. Beck merely handles telephone calls from individuals and computers, including computer-to-computer telephone calls (principal brief-page 5).

Appellant also contends that neither of the applied references is concerned with calculating cost of ownership of a configuration of a computer data center.

We have reviewed the evidence of record, including the arguments of appellant and the examiner, and we conclude therefrom that the examiner has not established a prima facie case of obviousness. Therefore, we will not sustain the rejection of claims 1-17, and 19-60 under 35 U.S.C. §103.

We reach this decision because, as we review the applied references, we agree with appellant's position that neither of these references is concerned with "assessing the financial cost of ownership of a configuration of at least one computer data center;" neither of these references is concerned with "modeling elements of a data center configuration;" and neither one of the references is concerned with providing in a knowledge base financial information which reflects financial ownership costs of the elements associated with a predetermined class of computers, including substantially all of the modelled elements of the given configuration."

Contrary to the examiner's view, Beck does not suggest anything whatsoever regarding assessing the financial cost of ownership of a configuration of a computer data center. Rather, Beck is only concerned with supporting and tracking diverse interaction paths within a multimedia communication center.

Moreover, the examiner's reliance on Beck, in the abstract, and in column 7, lines 1-2, and column 8, lines 1-11, for the concept of the claimed "modelling" step is misplaced. While line 7 at column 8, recites "tooled process models," it escapes us as

to how the examiner can turn this disclosure into a suggestion of “modeling elements of a data center configuration on a computer by identifying to the computer the elements of a given configuration.” This is especially so since Beck has nothing whatsoever to do with configuring computer data centers, as claimed.

Further misplaced is the examiner’s reliance on Li for a teaching of the financial cost of ownership limitation of the claims. Specifically, the examiner points to column 13, lines 61-67, and column 14, lines 1-11 and 32-54, of Li, for a disclosure of an expert system that has a knowledge base, an inference engine, etc. “and explanatory for rapidly generating, reliable, low cost knowledge bases” (answer-page 6). If the examiner is somehow relying on the “low cost knowledge bases” recitation as support for finding a teaching of assessing the financial cost of ownership of a computer data center, the examiner’s reliance is clearly in error as there is no mention whatsoever in Li, or in Beck, of assessing such a cost.

When given a chance to rebut appellant’s arguments in the principal brief, the examiner’s only response was to repeat, verbatim, the rationale set forth in Paper No. 5 (see pages 3-5 of the answer) and to make some nonsensical comments about appellant arguing that Beck does not teach a multimedia communication center (answer-page 5). On the contrary, appellant stated, at page 5 of the principal brief, that this is exactly what Beck taught but that a multimedia communication center is not the claimed “computer data center.”

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Because the examiner's rationale for the rejection of claims 1-17 and 19-60 under 35 U.S.C. §103 is so clearly deficient, we will not sustain this rejection.

The examiner's decision is reversed.

REVERSED

JAMES D. THOMAS
Administrative Patent Judge

ERROL A. KRASS
Administrative Patent Judge

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MAHSHID D. SAADAT
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